



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,706	12/22/2000	Mark S. Chee	A-66828-5/DJB/RMS/DCF	4006

7590

06/26/2003

Robin M. Silva, Esq.  
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP  
Suite 3400  
Four Embarcadero Center  
San Francisco, CA 94111-4187

EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

09/748,706

12/22/00

Chen et al

A 66828

EXAMINER

BS FORMAN

ART UNIT	PAPER
----------	-------

1634

0603

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

The amendment filed on 3 March 2003 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because the newly presented claims are drawn to a patently distinct invention.

The inventions are distinct, each from the other because:

The previously examined invention and the newly presented invention are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful to identify a single location on the substrate surface following a single hybridization step.

Furthermore, the previously examined invention and the newly presented invention are distinct because they have different modes of operation and different functions. The previously examined invention operates by providing an array of microsphere populations on a substrate and identifying microsphere location. In contrast the newly presented invention operates by providing an array of microsphere populations, providing and dividing a population of decoder probes, obtaining a first image by detecting a signal at each location on the array, dividing a population of decoder probes, obtaining a second data image by detecting a signal at each location on the array and finally analyzing the first and second data images. The previously examined invention functions to identify a microsphere location. In contrast, the newly presented invention functions to analyze first and second data images. For the reasons stated above, the previously examined invention and the newly presented invention are distinct.

The inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
BJ Forman, Ph.D.  
Patent Examiner  
Art Unit: 1634

June 25, 2003